

### REMARKS

By this Reply, claims 1, 5, 24, and 25 are amended, new claims 27-30 are added, and claim 26 is canceled without prejudice or disclaimer of the subject matter therein. Claims 1-25 and 27-30 are therefore pending in this application, with claims 1, 25 and 30 being independent.

#### **§ 112 Rejection: Claims 1-26**

In the Office Action of April 14, 2008 ("Office Action"), claims 1-26 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Referring to independent claims 1, 25 and 26, the Office Action states: "It is unclear if the object is delivered in the message, and if this is the case it is further unclear since the previous step has separated the object from the message. An alternative interpretation would be that the object is not delivered inside the message but separate." Office Action, p. 2, ¶ 3. This argument, however, does not properly support a rejection under § 112, second paragraph.

The absence of language clarifying a point does not render a claim indefinite. Rather, it simply leaves the claim open to either interpretation. Here, assuming the assertion of the Office Action is correct, the claims would unambiguously require delivery of both the object in the message and separate from the message. In other words, the issue pointed to by the Office Action is one of scope rather than ambiguity.

The section 112 rejection of claim 26 is rendered moot by the cancellation of that claim. Further, claims 1-25 are definite under section 112, second paragraph, and thus the rejection of these pending claims should be withdrawn.

#### **§ 101 Rejection: Claim 26**

In the Office Action, claim 26 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection of claim 26 is rendered moot by the cancellation of that claim.

**§ 102 Rejection: Claims 1-13, 15-17, 19-22, 25, and 26**

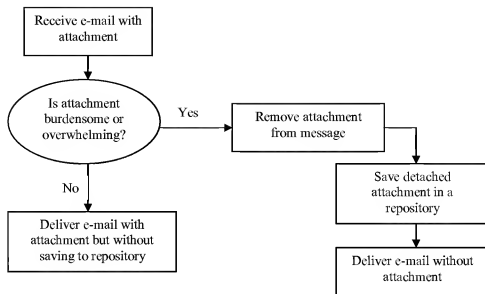
In the Office Action, claims 1-13, 15-17, 19-22, 25, and 26 were rejected under 35 U.S.C. § 102 based on U.S. Patent Application Publication No. 2002/0016818 ("Kirani"). Claim 26 has been canceled, thus rendering moot its rejection under section 102. The section 102 rejection of claims 1-13, 15-17, 19-22, and 25 based on Kirani should be withdrawn because Kirani fails to anticipate these claims, as now amended.

Amended independent claim 1 recites a combination including:

identifying an embedded multimedia object embedded within the identified electronic message or an attached multimedia object attached to the identified electronic message;

delivering the electronic message to the destination with an un-altered, viewable version of the identified multimedia object and automatically saving the un-altered, viewable version of the identified multimedia object to a repository for subsequent use by a user.

Kirani fails to disclose at least these "identifying" and "delivering" features. Kirani is directed to optimizing delivery of e-mail attachments. *See* Abstract. In particular, in Kirani's system, an e-mail attachment is removed from the e-mail message and stored in a network repository if the attachment is determined to be burdensome or overwhelming. *See* Abstract; *see also* ¶ 0037. "Any detached attachment is saved in a network media-sharing repository, and can be subsequently accessed via a link (e.g., URL) referencing that storage address." Abstract. Figures 5A and 5B illustrate the operation of Kirani's system, and have been summarized in the following diagram for clarity.



As the above flowchart makes clear, Kirani does not disclose or suggest a situation in which the email attachment is both delivered to the destination and saved to the repository. Rather, in the method disclosed by Kirani, when the attachment is detached and saved, only a link to the saved attachment is sent with the e-mail to the destination, not the attachment itself. *See, e.g.*, Kirani, Abstract. Therefore, Kirani does not disclose the “identifying” and “delivering” features, required by independent claim 1.

Furthermore, the Office Action asserts that Kirani discloses a method “wherein the object/attachment is separated from the message and delivered separately from the message.” *See* Office Action, p. 7, ¶ 1. In fact, as discussed above, Kirani does not disclose delivering the object/attachment separately from the message, but rather delivering a link to the attachments location in a repository. *See, e.g.*, Kirani, Abstract.

Amended independent claim 25 recites a combination including “delivering the electronic message to the destination with an un-altered, viewable version of the separated multimedia object and automatically saving the un-altered, viewable version of the separated multimedia object to a repository for subsequent use by a user.” Thus, the section 102 rejection of claim 25 based on Kirani should be withdrawn for at least reasons similar to those presented above in connection with claim 1.

Because Kirani fails to disclose each and every feature of independent claims 1 and 25, Applicant requests withdrawal of the section 102 rejection and the timely allowance of claims 1-13, 15-17, 19-22, 25, and 26.

**§ 103 Rejection: Claims 14 and 18**

In the Office Action, claims 14 and 18 were rejected under 35 U.S.C. § 103 based on Kirani and U.S. Patent Application Publication 2002/0184309 ("Danker"). Claims 14 and 18 depend upon claim 1. As discussed above, Kirani fails to disclose or suggest each and every feature of independent claim 1. Danker, which was applied to certain features of claims 14 and 18, fails to cure the deficiencies of Kirani with respect to independent claim 1. Furthermore, no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. See M.P.E.P. § 2143.01(VI), 8th Ed., Rev. 6 (September 2007). Accordingly, Kirani and Danker—whether taken alone or in any combination—fail to render obvious claim 1 or its dependent claims 14 and 18. Withdrawal of the section 103 rejection and the timely allowance of dependent claims 14 and 18 is therefore requested.

**§ 103 Rejection: Claims 23 and 24**

In the Office Action, claims 23 and 24 were rejected under 35 U.S.C. § 103 based on Kirani and U.S. Patent No. 6,856,999 ("Flanagin"). Claims 23 and 24 depend upon claim 1. As discussed above, Kirani fails to disclose or suggest each and every feature of independent claim 1. Flanagin, which was applied to certain features of claims 23 and 24, fails to cure the deficiencies of Kirani with respect to independent claim 1. Furthermore, no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. See M.P.E.P. § 2143.01(VI), 8th Ed., Rev. 6 (September 2007). Accordingly, Kirani and Flanagin—whether taken alone or in any combination—fail to render obvious claim 1 or its dependent claims 23 and 24. Withdrawal of

the section 103 rejection and the timely allowance of dependent claims 23 and 24 is therefore requested.

#### **New claims 27-30**

New claims 27-29 depend upon claim 1 and are similarly not anticipated or rendered obvious by the applied art. The applied art further fails to disclose or suggest at least some of the additional features of new dependent claims 27-29.

New independent claim 30 recites, among other things:

identifying embedded multimedia objects embedded within the identified electronic messages or attached multimedia objects attached to the identified electronic messages; and  
delivering the electronic messages to the multiple destinations with un-altered, viewable versions of the identified multimedia objects and automatically saving the un-altered, viewable versions of the identified multimedia objects to a single repository for subsequent use by users.

Kirani fails to disclose at least these “identifying” and “delivering” features.

As described above, Kirani does not disclose or suggest a situation in which the email attachment is both delivered to the destination and saved to the repository. Furthermore, Kirani does not disclose or suggest a single repository for saving viewable versions of the identified multimedia objects embedded within electronic messages intended for multiple, different destinations. Therefore, Kirani does not disclose the “identifying” and “delivering” features, required by new independent claim 30.

For at least these reasons, the timely allowance of the new claims 27-30 is therefore requested.

#### **Conclusion**

It is requested that the Examiner reconsider the application in view of the amendments and foregoing remarks and timely allow pending claims 1-25 and 27-30.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. The Office Action, however, contains a number of statements reflecting

characterizations of the related art and the claims. Whether or not any such statement is identified herein does not constitute an automatic subscription to any statement or characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, a telephone call to the undersigned would be appreciated since this may expedite prosecution of the application.

It is hereby petitioned that the period for response to the Office Action be extended for one (1) month. The Petition for Extension of Time fee of \$120.00 and the Excess Claim fee of \$150.00 are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please grant any additional extensions of time required to enter this paper and apply any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 8/14/08

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